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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,707	07/10/2008	Benjamin BREITENSTEIN	C23010	8777
324 7590 06/29/2011 BASF Corporation Patent Department 500 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER FANG, SHANE	
			ART UNIT 1766	PAPER NUMBER
			NOTIFICATION DATE 06/29/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/586,707

Applicant(s)

BREITENSTEIN ET AL.

Examiner

SHANE FANG

Art Unit

1766

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 June 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-5,9 and 10

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/RANDY GULAKOWSKI/
Supervisory Patent Examiner, Art Unit 1766

/SHANE FANG/
Examiner, Art Unit 1766

Continuation of 11, does NOT place the application in condition for allowance because: The previous rejection of claim 8 has been rendered moot by cancellation.

The applicant argued (Pg. 8, 9) the previous 103 rejection of claim 1 by attacking Tonnvick fails to teach "squeeze" roller but rather transport roller for strands while this invention produces a "roll out plastic". The examiner disagrees. The examiner asserts Tonnvick is silent on impressing, but the rolling would inherently results in impressing or squeezing because of the pressure between rolls and the materials being squeezed in between, as obviously recognized by one of ordinary skill in the art. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. A case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See MPEP § 2184. In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Moreover, Hovis's engraved roller would also impress or squeeze the materials. Tonnvick's polymer additives rolled, squeezed, and transferred by rolls can be considered as "roll out plastic". Thus, Tonnvick does not teach away from this invention.

The applicant argued (Pg. 9, 1-3) the examiner applied improper hindsight analysis and Tonnvick and Hovis are non-analogous. The examiner disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner asserts Tonnvick and Hovis are analogous arts. Tonnvick is an analogous art, because it discloses a process of producing low dust granulate via rollers. Hovis is an analogous art, because it pertains to forming porous films with net-like structures that contains polymer additives via rollers. Hovis discloses a process of preparing porous films with net-like patterns (1:5-15, Fig. 1-9, 1:58-68, 2:1-25) comprising polymers and other additives by passing extrudate of polymer composition (workable state) through rolls having linearly engraved (embossing) lines. Hovis further implies said rolls having grooves by showing grooves on the resultant porous films with net-like structures. In light of this, Tonnvick and Hovis are in the field of applicant's endeavor of forming shaped polymer articles comprising additives via rollers.

The applicant argued (Pg. 9, 4) no motivation is taught by Tonnvick and Hovis. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this particular case, in view of Hovis, one of ordinary skill in the art would obviously recognize to add engraved roller having grooves to shape sheet like polymer additives after extrusion and roll compacting into porous, net-like patterns, which facilitates the sequential comminuting process (forming smaller particle size articles) of Tonnvick.

The applicant argued (Pg. 9, 5) combining Tonnvick and Hovis would not expect success. The applicant merely argued the success of this invention is demonstrated in examples of this invention but showed no evidence that Tonnvick and Hovis would not expect success. This argument is not persuasive. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

Therefore, as to claims 1, 4-5, and 9, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the process disclosed by Tonnvick, applied the first compacting roller with smooth surface, added the second roller with the engraved roller having grooves in view of Hovis, and add continuous steel belt for cooling and solidification in view of Legge before the comminuting process of Tonnvick, because the resultant process would facilitate materials transfer and granulation process.

Furthermore, the resultant process would yield a more efficient cooling and solidification process that facilitate the comminuting of particles due to the reduction of materials tackiness and entanglement cause by higher temperature. In addition, the granules would inherently be formed along the impressed lines formed particularly via the shaping rolls of Hovis, because those rolls have embossing lines and shaping rolls having grooves that can create holes (Fig. 1-9). One of ordinary skill in the art would obviously recognize the granules would be formed due to said holes (their edges are impressed lines) in the sequential comminuting process of Tonnvick. Therefore, the previous 103 rejections of claims 1, 4-5, and 9 over Tonnvick et al. in view of Hovis et al. and in further view of Legge et al. have been maintained.

Therefore, as to claims 2-3, it would have been obvious to one of ordinary skill in the art at the time of the invention to have replaced phenol based antioxidant with tetrakis[3-(3,5-di-*t*-butyl-4-hydroxyphenyl)propionyloxymethyl] methane and octadecyl-3-(3',5'-di-*t*-butyl-4'-hydroxyphenyl)propionate because of their equivalent functionality as antioxidants and produce these additives via the generic process of Tonnvick. These conditions appear to equally apply to both polymer additive productions using similar primary antioxidants. This adaptation would have obviously yielded instantly claimed invention.

Therefore, as to claim 10, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the process disclosed by Tonnvick and added the sieve granulator in view of Neri, because the resultant process would yield improved granulation and separate and remove particles of undesired size.

Therefore, the previous 103 rejections of claims 2-3 and 10 over Tonnvick et al. in view of Hovis et al., in further view of Legge et al., and further in view of Neri et al. have been maintained.